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EXAMINER

MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 08/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/908,988

Applicant(s)

OLSON ET AL.

Examiner

William W. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-115 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

*Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- 5 I. Claims 1-6 and 8-18, each drawn in part to a nucleic acid segment that encodes a MURF-1 polypeptide, to expression cassettes, vectors, and host cells comprising same, and to a recombinant method of making the encoded MURF-1 polypeptide utilizing said host cells, classified in class 435, subclass 69.1.
- 10 II. Claims 1-6 and 8-18, each drawn in part to a nucleic acid segment that encodes a MURF-2 polypeptide, to expression cassettes, vectors, and host cells comprising same, and to a recombinant method of making the encoded MURF-2 polypeptide utilizing said host cells, classified in class 435, subclass 69.1.
- 15 III. Claims 1-6 and 8-18, each drawn in part to a nucleic acid segment that encodes a MURF-3 polypeptide, to expression cassettes, vectors, and host cells comprising same, and to a recombinant method of making the encoded MURF-3 polypeptide utilizing said host cells, classified in class 435, subclass 69.1.
- IV. Claim 7, drawn in part to an expression construct for transcription of a polynucleotide that is antisense to a nucleic acid sequence encoding at least part of a MURF-1 polypeptide, classified in class 536, subclass 24.5.
- 20 V. Claim 7, drawn in part to an expression construct for transcription of a polynucleotide that is antisense to a nucleic acid sequence encoding at least part of a MURF-2 polypeptide, classified in class 536, subclass 24.5.
- VI. Claim 7, drawn in part to an expression construct for transcription of a polynucleotide that is antisense to a nucleic acid sequence encoding at least part of a MURF-3 polypeptide, classified in class 536, subclass 24.5.
- 25 VII. Claims 19-40, drawn to any one of at least 6,566 pentadecanucleotide species, as well as larger oligonucleotide species, present within any of SEQ IDs NOs:1, 3 and 5, and to a composition comprising same and a kit comprising same, classified in class 536, subclass 24.3.
- 30 VIII. Claims 41 and 44-50, drawn to any one of at least 1,224 decapeptide species, as well as larger oligopeptides species, present within any of SEQ IDs NOs:2, 4 and 6, and to a composition comprising same, classified in class 530, subclass 300.
- IX. Claims 42 and 43, each drawn in part to a purified or recombinantly produced MURF-1 polypeptide, classified in class 530, subclass 350.
- 35 X. Claims 42 and 43, each drawn in part to a purified or recombinantly produced MURF-2 polypeptide, classified in class 530, subclass 350.
- XI. Claims 42 and 43, each drawn in part to a purified or recombinantly produced MURF-3 polypeptide, classified in class 530, subclass 350.
- 40 XII. Claims 52-55 and 57-60, each drawn in part to a composition that comprises an antibody capable of binding to an epitope presented by the MURF-1 polypeptide having the amino acid sequence set forth in SEQ ID NO:2 and to an immunodetection kit comprising same, classified in class 530, subclass 387.1.

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XIII. Claims 52-55 and 57-60, each drawn in part to a composition that comprises an antibody capable of binding to epitope presented by the MURF-2 polypeptide having the amino acid sequence set forth in SEQ ID NO:4 and to an immunodetection kit comprising same, classified in class 530, subclass 387.1.

5 XIV. Claims 52-55 and 57-60, each drawn in part to a composition that comprises an antibody capable of binding to epitope presented by the MURF-3 polypeptide having the amino acid sequence set forth in SEQ ID NO:6 and to an immunodetection kit comprising same, classified in class 530, subclass 387.1.

10 XV. Claim 56, drawn in part to a hybridoma cell that produces a monoclonal antibody that will bind specifically to a MURF-1 polypeptide having the amino acid sequence set forth in SEQ ID NO:2, classified in class 435, subclass 70.21.

XVI. Claim 56, drawn in part to a hybridoma cell that produces a monoclonal antibody that will bind specifically to a MURF-2 polypeptide having the amino acid sequence set forth in SEQ ID NO:4, classified in class 435, subclass 70.21.

15 XVII. Claim 56, drawn in part to a hybridoma cell that produces a monoclonal antibody that will bind specifically to a MURF-3 polypeptide having the amino acid sequence set forth in SEQ ID NO:6, classified in class 435, subclass 70.21.

20 XVIII. Claims 61-66 drawn in part to a method for detecting an alteration in MURF-1 polypeptide function by assessing the expression level of a nucleic acid encoding the polypeptide in a cell, classified in class 435, subclass 6.

XIX. Claims 61-66 drawn in part to a method for detecting an alteration in MURF-2 polypeptide function by assessing the expression level of a nucleic acid encoding the polypeptide in a cell, classified in class 435, subclass 6.

25 XX. Claims 61-66 drawn in part to a method for detecting an alteration in MURF-3 polypeptide function by assessing the expression level of a nucleic acid encoding the polypeptide in a cell, classified in class 435, subclass 6.

XXI. Claims 61, 65 and 67-69, drawn in part to a method for detecting an alteration in MURF-1 polypeptide function by assessing the level of thereof in a cell, classified in class 435, subclass 7.

30 XXII. Claims 61, 65 and 67-69, drawn in part to a method for detecting an alteration in MURF-2 polypeptide function by assessing the level of thereof in a cell, classified in class 435, subclass 7.

35 XXIII. Claims 61, 65 and 67-69, drawn in part to a method for detecting an alteration in MURF-3 polypeptide function by assessing the level of thereof in a cell, classified in class 435, subclass 7.

XXIV. Claims 70-77 and 97-100, drawn in part to a method of *in vivo* therapy for increasing the level of MURF-1 polypeptide activity in a cell comprising administering to a cell an expression construct for production of the MURF-1 polypeptide, classified in class 424, subclass 93.2.

40 XXV. Claims 70-77 and 97-100, drawn in part to a method of *in vivo* therapy for increasing the level of MURF-2 polypeptide activity in a cell comprising administering to a cell an expression construct for production of the MURF-2 polypeptide, classified in class 424, subclass 93.2.

45 XXVI. Claims 70-77 and 97-100, drawn in part to a method of *in vivo* therapy for increasing the level of MURF-3 polypeptide activity in a cell comprising

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administering to a cell an expression construct for production of the MURF-3 polypeptide, classified in class 424, subclass 93.2.

XXVII. Claims 78-81, drawn in part to assay methods for detecting a non-specific substance capable of binding a MURF-1 polypeptide, classified in class 435, subclass 7.8.

XXVIII. Claims 78-81, drawn in part to assay methods for detecting a non-specific substance capable of binding a MURF-2 polypeptide, classified in class 435, subclass 7.8.

XXIX. Claims 78-81, drawn in part to assay methods for detecting a non-specific substance capable of binding a MURF-3 polypeptide, classified in class 435, subclass 7.8.

XXX. Claims 82 and 83, drawn in part to assay methods for detecting a non-specific substance capable of affecting the levels of MURF-1 in a cell, classified in class 435, subclass 7.21.

XXXI. Claims 82 and 83, drawn in part to assay methods for detecting a non-specific substance capable of affecting the levels of MURF-2 in a cell, classified in class 435, subclass 7.21.

XXXII. Claims 82 and 83, drawn in part to assay methods for detecting a non-specific substance capable of affecting the levels of MURF-3 in a cell, classified in class 435, subclass 7.21.

XXXIII. Claims 84-88, 90, 91, and 109-114, drawn in part to assay methods for detecting a non-specific substance capable of affecting MURF-1 interaction with microtubules or intermediate filaments, classified in class 436, subclass 63.

XXXIV. Claims 84-88, 90, 91, and 109-114, drawn in part to assay methods for detecting a non-specific substance capable of affecting MURF-2 interaction with microtubules or intermediate filaments, classified in class 436, subclass 63.

XXXV. Claims 84-88, 90, 91, and 109-114, drawn in part to assay methods for detecting a non-specific substance capable of affecting MURF-3 interaction with microtubules or intermediate filaments, classified in class 436, subclass 63.

XXXVI. Claim 89, drawn in part to assay methods for detecting a non-specific substance capable of affecting MURF-1 homodimerization, classified in class 436, subclass 86.

XXXVII. Claim 89, drawn in part to assay methods for detecting a non-specific substance capable of affecting MURF-2 homodimerization, classified in class 436, subclass 86.

XXXVIII. Claim 89, drawn in part to assay methods for detecting a non-specific substance capable of affecting MURF-3 homodimerization, classified in class 436, subclass 86.

XXXIX. Claims 92-96, drawn in part to a transgenic animal comprising a MURF-1-encoding nucleic acid sequence integrated into its genome and under the control of a heterologous promoter, classified in class 800, subclass 14.

XL. Claims 92-96, drawn in part to a transgenic animal comprising a MURF-2-encoding nucleic acid sequence integrated into its genome and under the control of a heterologous promoter, classified in class 800, subclass 14.

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XLI. Claims 92-96, drawn in part to a transgenic animal comprising a MURF-3-encoding nucleic acid sequence integrated into its genome and under the control of a heterologous promoter, classified in class 800, subclass 14.

5 XLII. Claims 101-108, drawn in part to methods for modulating the activity of a MURF-1 polypeptide in a cell, or blocking MURF-1 expression in a cell, comprising the administration of an agent capable of modulating MURF-1 activity or capable of blocking MURF-1 expression, classified in class , subclass .

10 XLIII. Claims 101-108, drawn in part to a transgenic animal comprising a MURF-2-encoding nucleic acid sequence integrated into its genome and under the control of a heterologous promoter, classified in class 800, subclass 14.

XLIV. Claims 101-108, drawn in part to a transgenic animal comprising a MURF-3-encoding nucleic acid sequence integrated into its genome and under the control of a heterologous promoter, classified in class 800, subclass 14.

15 XLV. Claim 115, drawn to a method for screening for a substance capable of affecting the heterodimerization of any of the MURF-1, MURF-2, and MURF-3 polypeptides comprising contacting a composition comprising two or more of MURF-1, MURF-2, and MURF-3 polypeptides with a candidate substance and determining an effect thereof on heterodimerization, classified in class 436, subclass 86.

20 Inventions of Groups I-III are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different coding capacities, are not disclosed as capable of use together, and encode products with different functions and  
25 effects.

Because these inventions are distinct for the reasons given above and the search required for any one of Groups I-III is not required for another of Groups I-III, restriction for examination purposes as indicated is proper.

30 Inventions of Groups IV-VI are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different nucleic acid sequences, are not disclosed as capable of use together, and have different functions and effects.

35 Because these inventions are distinct for the reasons given above and the search required for any one of Groups IV-VI is not required for another of Groups IV-VI, restriction for examination purposes as indicated is proper.

Inventions of Groups IX-XI are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have

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different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different primary and secondary structures, are not disclosed as capable of use together, and have different functions and effects.

5        Because these inventions are distinct for the reasons given above and the search required for any one of Groups IX-XI is not required for another of Groups IX-XI, restriction for examination purposes as indicated is proper.

10        Inventions of Groups XII-XIV are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different recognition capacities, are not disclosed as capable of use together, and have different functions and effects.

15        Because these inventions are distinct for the reasons given above and the search required for any one of Groups XII-XIV is not required for another of Groups XII-XIV, restriction for examination purposes as indicated is proper.

20        Inventions of Groups XV-XVII are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different production capacities, are not disclosed as capable of use together, and have different functions and effects.

25        Because these inventions are distinct for the reasons given above and the search required for any one of Groups XV-XVII is not required for another of Groups XV-XVII, restriction for examination purposes as indicated is proper.

30        Inventions of Groups XVIII-XX are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

      Because these inventions are distinct for the reasons given above and the search required for any one of Groups XVIII-XX is not required for another of Groups XVIII-XX, restriction for examination purposes as indicated is proper.

35        Inventions of Groups XXI-XXIII are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they

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have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation and effects.

5 Because these inventions are distinct for the reasons given above and the search required for any one of Groups XXI-XXIII is not required for another of Groups XXI-XXIII, restriction for examination purposes as indicated is proper.

10 Inventions of Groups XXIV-XXVI are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation and effects.

Because these inventions are distinct for the reasons given above and the search required for any one of Groups XXIV-XXVI is not required for another of Groups XXIV-XXVI, restriction for examination purposes as indicated is proper.

15 Inventions of Groups XXVII-XXIX are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation and effects.

20 Because these inventions are distinct for the reasons given above and the search required for any one of Groups XXVII-XXIX is not required for another of Groups XXVII-XXIX, restriction for examination purposes as indicated is proper.

25 Inventions of Groups XXX-XXXII are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation and effects.

30 Because these inventions are distinct for the reasons given above and the search required for any one of Groups XXX-XXXII is not required for another of Groups XXX-XXXII, restriction for examination purposes as indicated is proper.

35 Inventions of Groups XXXIII-XXXV are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation and effects.



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Because these inventions are distinct for the reasons given above and the search required for any one of Groups XXXIII-XXXV is not required for another of Groups XXXIII-XXXV, restriction for examination purposes as indicated is proper.

5       Inventions of Groups XXXVI-XXXVIII are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation and effects.

10       Because these inventions are distinct for the reasons given above and the search required for any one of Groups XXXVI-XXXVIII is not required for another of Groups XXXVI-XXXVIII, restriction for examination purposes as indicated is proper.

15       Inventions of Groups XXXIX-XLI are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation, functions, and effects.

20       Because these inventions are distinct for the reasons given above and the search required for any one of Groups XXXIX-XLI is not required for another of Groups XXXIX-XLI, restriction for examination purposes as indicated is proper.

25       Inventions of Groups XLII-XLIV are unrelated, one to another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation, functions, and effects.

Because these inventions are distinct for the reasons given above and the search required for any one of Groups XLII-XLIV is not required for another of Groups XLII-XLIV, restriction for examination purposes as indicated is proper.

30       Inventions of Groups I-III are unrelated, respectively, to inventions of Groups IV-VI. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation,  
35       functions, and effects.

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Inventions of Groups I-III are related, respectively, to inventions of Groups IX-XI as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, solid phase chemical synthesis.

Inventions of Groups I-III and Group VIII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because none of the three integral, coding, combinations need not consist of the individual oligonucleotides. The subcombinations have separate utility such as a probe or primer.

Inventions of Groups I-III are related, respectively, to inventions of Groups XVIII-XX as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, such as recombinant production of an encoded MURF polypeptide.

Inventions of Groups I-III are related, respectively, to inventions of Groups XXIV-XXVI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, such as recombinant production of an encoded MURF polypeptide for isolation and recovery.

Inventions of Groups I-III are unrelated, respectively, to inventions of Groups XII-XIV, XV-XVII, XXI-XXIII, XXVII-XXIX, XXX-XXXII, XXXIII-XXXV, XXXVI-XXXIX, XL-XLII, XLIII-XLV and XLVI. Inventions are unrelated if it can be shown that they are not

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disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

5        Inventions of Groups IV-VI are unrelated to inventions of Groups V-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

10        Inventions of Group VII and Groups XVIII-XX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the  
15        process for using the product as claimed can be practiced with another materially different product, a product of Groups I-III.

      Inventions of Group VII are unrelated to inventions of Groups VIII-XVII and XXI-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different  
20        effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

      Inventions of Groups IX-XI are related as combination and subcombination to Group VIII. Inventions in this relationship are distinct if it can be shown that (1) the combination  
25        as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combinations as claimed do not require the particulars of the subcombination as claimed because the combinations may be used in an assay method to detect substances affecting MURF homodimerization. A subcombination  
30        has separate utility such as ligation to a carrier molecule to present an epitope distinct from those presented by the combinations.

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5       Inventions of Group VIII are unrelated to inventions of Groups XII-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

10       Inventions of Groups IX-XI are unrelated to inventions of Groups XII-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

15       Inventions of Groups XII-XIV are unrelated to inventions of Groups XV-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

20       Inventions of Groups XV-XVII are unrelated to inventions of Groups XVIII-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

25       Inventions of Groups XVIII-XX are unrelated to inventions of Groups XXI-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

30       Inventions of Groups XXI-XXIII are unrelated to inventions of Groups XXIV-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions

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are not disclosed as capable of use together and have different modes of operation, functions, and effects.

5       Inventions of Groups XXIV-XXVI are unrelated to inventions of Groups XXVII-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

10       Inventions of Groups XXVII-XXIX are unrelated to inventions of Groups XXX-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

15       Inventions of Groups XXX-XXXII are unrelated to inventions of Groups XXXIII-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation,  
20       functions, and effects.

      Inventions of Groups XXXIII-XXXV are unrelated to inventions of Groups XXXVI-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions  
25       are not disclosed as capable of use together and have different modes of operation, functions, and effects.

      Inventions of Groups XXXVI-XXXVIII are unrelated to inventions of Groups XXXIX-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different  
30       effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

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Inventions of Groups XXXIX-XLI are unrelated to inventions of Groups XLII-XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

Inventions of Groups XLII-XLIV are unrelated to the invention of Group XLV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, functions, and effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Claims 19-40 are generic to a plurality of disclosed patentably distinct species comprising well over 6,566 oligonucleotides. Applicant is required under 35 U.S.C. §121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

Claims 41 and 44-50 are generic to a plurality of disclosed patentably distinct species comprising well over 1,224 peptides. Applicant is required under 35 U.S.C. §121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

A telephone call was made to Mr. Steven L. Highlander on August 26, 2002, to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be

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complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

- 5 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Conclusion*

- 10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 703.308.0583. The examiner can normally be reached between 7:00AM-5:30PM EST on Mondays and Wednesdays, between 7:00AM-1:30PM EST on Tuesdays and Thursdays, and between 8:30AM and 5:00PM EST on Fridays. The examiner's direct FAX telephone number is 703.746.3169. If attempts to reach the examiner by  
15 telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached at 703.308.3804. Further fax phone numbers for the organization where this application or proceeding is assigned are 703.308.4242 for regular communications and 703.308.0294 for After Final communications. Any inquiry of a general nature or  
20 relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0196.

William W. Moore  
August 26, 2002

  
PONNATHAPURACHUTAMURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600